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10/829,295	04/22/2004	Hiroshi Inoue	0054-0285PUS1	7220

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EXAMINER	
BECKLEY, JONATHAN R	

ART UNIT	PAPER NUMBER
4178	

NOTIFICATION DATE	DELIVERY MODE
11/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/829,295	INOUE ET AL.	
	Examiner	Art Unit	
	Jonathan R. Beckley	4178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *all*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 claims "A printing service program for causing a computer to execute processing ..." However, the claims do not define a printing service program to be a functional descriptive material encoded on a computer readable medium, i.e., memory/disk, see Applicant's specification, and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized").

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time ***excluding*** the intangible media such as signals, carrier waves, etc... defined in the specification. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1, 2, 6, and 8-11** are rejected under **35 U.S.C. 102(e)** as being unpatentable by **Watanabe et el. (US Patent Number 6,877,031 B2)**.

3. Regarding **Claim 1, Watanabe** teaches a printing service system **(Column 1, lines 7-9)** comprising:

a server **Figure 1, element 12, center server)**;

and at least one print terminal connected to the server through a communication network **(Figure 1, elements 3 and 4)**,

the print terminal including:

an image data input means for inputting image data **(Figure 1, elements 7 and 10)**;

an image data transmission means for transmitting the image data to the server **(Figure 1, internet and dedicated lines in which all devices**

connected to it must have a communication interface with the connected network);

and a destination input means for inputting an address of a recipient authorized to print the image data **(Column 3, lines 1-8)**,

and the server including:

an image data reception means for receiving the image data transmitted by the image data transmission means **(Column 2, lines 38-43)**;

an ID and password generation means for generating an ID and a password for authentication when the image data is received **(Column 7, lines 28-31; in order to check and compare the ID and passwords to an existing pair of Ids and passwords it is met that the ID and passwords would have to be generated)**;

an image data accumulation means **(storage)** for accumulating the received image data in association with the ID **(Column 2, lines 25-36)**;

a code conversion means **(application server)** for converting the ID and the password into a code storing information on the ID and the password **(see Abstract; Column 7, lines 28-31, user information database)**;

a code transmission means **(mail transmitting)** for transmitting the obtained code to the address inputted by the destination input means **(Column 3, lines 9-12)**; and an image data returning means for, when the print terminal decodes the code to the ID and the password and transmits the ID and the password, performing authentication using the ID and the

password and, if a positive authentication result is obtained, reading the image data corresponding to the ID from the image data accumulation means and returning the read image data to the print terminal **(Column 7, lines 31-36)**.

Regarding **Claim 2, Watanabe** further discloses the address of the recipient is an e-mail address of the recipient **(Column 2, lines 19-24)**;

and the code transmission means transmits the code by e-mail **(Column 2, lines 19-24)**.

Regarding **Claim 6, Watanabe** further discloses the server includes a Web site showing an installation place of the print terminal **(Column 4, lines 11-19; Column 6, line 62 – Column 7, line 16)**.

Regarding **Claim 8, Watanabe** further discloses the print terminal further includes an attribute information input means for, when transmitting the image data to the server using the image data transmission means, inputting attribute information to be attached to the image data **(Column 2, lines 25-36; Column 3, lines 9-31)**;

and the image data accumulation means of the server stores the attribute information together with the image data **(Column 2, lines 25-36)**.

Regarding **Claim 9, Watanabe** further discloses the code transmission means of the server transmits the attribute information to the address of the recipient together with the code **(Column 3, lines 9-31)**.

Regarding **Claim 10, Watanabe** further discloses the image data returning means of the server transmits the attribute information to the print terminal together with the image data **(Column 3, lines 9-31)**.

Regarding **Claim 11, Watanabe** further discloses the server further includes a user management table in which the ID, the password, and an address of a user directory storing the image data in the image data accumulation means are stored in association with information about the address of the recipient **(Column 7, lines 28-36, user information database)**.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 3, 5, 7, 12, and 13** are rejected under **35 U.S.C. 103(a)** as being unpatentable over obviousness by **Watanabe et el. (US Patent Number 6,877,031 B2)** further in view of **Yamamoto et al. (US Patent Number 7,228,339 B2)**.

Regarding **Claim 3, Watanabe** does disclose a printing service system with an address of a recipient **(Column 1, lines 7-9 and Column 2, lines 38-43).**

Watanabe does not disclose the address of the recipient is a FAX number of the recipient; and the code transmission means transmits the code by fax.

However, **Yamamoto** does disclose the address of the recipient is a FAX number of the recipient; and the code transmission means transmits the code by fax **(Figure 1, elements 15, 39, and s6)**.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to further enhance the information system mobility by adding communications means between the FAX terminal and the remote printing server to expand the type and locations of users to access the system.

Regarding **Claim 7, Yamamoto** further discloses when transmitting the code by fax, the code transmission means attaches a map illustrating an installation place of the print terminal in the vicinity of an installation place of a facsimile machine on a recipient side **(Figure 10(c) and Figure 11; and Column 18, lines 1-17)**.

Regarding **Claim 5, Watanabe** does disclose a printing service system comprising a print terminal **(Column 1, lines 7-9 and Figure 1, elements 3 and 4).**

Watanabe does disclose an image data acquiring means for transmitting the ID and the password to the server and receiving the image data corresponding to the ID returned by the image data returning means of the server **(Column 7, lines 28-36)**; and a print means for printing the received image data **(Figure 1, elements 9 and 11)**.

Watanabe does not disclose the print terminal further includes: a code reading means for reading the code; a code decoding means for decoding the read code so as to return it into the ID and the password.

However, **Yamamoto** does disclose the print terminal further includes: a code reading means for reading the code **(Column 5, lines 1-5)**; a code decoding means for decoding the read code so as to return it into the ID and the password **(Column 5, lines 42-51).**

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to conduct encryption when transmitting information and conduct decryption when receiving the encrypted information to further enhance the personal authentication function section of the invention.

Regarding **Claim 12, Watanabe** does disclose a printing service system **(Column 1, lines 7-9).**

Watanabe does not disclose a customer master that is provided for one of the server and the print terminal and stores a transmission history in association with a corresponding sender ID.

However, **Yamamoto** does disclose a customer master that is provided for one of the server and the print terminal and stores a transmission history in association with a corresponding sender ID **(Figure 13C; Column 6, lines 13-21)**.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to not only keep track of money charging, but also for security improvement to give the user an option of viewing or printing the product.

Regarding **Claim 13, Watanabe** does teach a printing service program for causing a computer to execute processing **(Column 1, lines 7-9; and Column 6, lines 52-65)** comprising the steps of:

transmitting image data from a print terminal to a server **(Figure 1, internet and dedicated lines)**;

inputting an address of a recipient authorized to print the image data into the print terminal **(Column 3, lines 1-8)**;

receiving by the server the image data transmitted from the print terminal in the image data transmission step **(Column 2, lines 38-43)**;

generating an ID and a password for authentication by the server when receiving the image data **(Column 7, lines 28-31; in order to check and compare the ID and passwords to an existing pair of Ids and passwords it is met that the ID and passwords would have to be generated)**;

accumulating by the server the received image data in association with the ID **(Column 2, lines 25-36)**;

converting by the server the ID and the password into a code having an information on the ID and the password **(see Abstract; Column 7, lines 28-31, user information database)**;

transmitting the code by the server to the address inputted in the address input step **(Column 3, lines 9-12)**;

performing authentication by the server using the ID and the password obtained through decoding **(Column 7, lines 31-36)**;

reading by the server, if a positive authentication result is obtained in the authentication step, the image data corresponding to the ID accumulated in the server in the image data accumulation step; and returning by the server the read image data to the print terminal **(Column 7, lines 31-36)**.

Watanabe does not teach decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server.

Yamamoto does teach decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server **(Column 5, lines 42 – 51)**.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to provide an information storage output service for storing predetermined storage data in a storage server on a network, the storage being capable of being accessed from many and unspecified communication devices to peruse and print out data stored in the storage server.

1. **Claim 4 is** rejected under **35 U.S.C. 103(a)** as being unpatentable over obviousness by **Watanabe et el. (US Patent Number 6,877,031 B2)** further in view of **Banerjee et al. (US Patent Number 6,748,296 B2).**

Regarding **Claim 4, Watanabe** does disclose a printing service system **(Column 1, lines 7-9).**

Watanabe does not disclose the code is composed of one of a two-dimensional code and a barcode.

Banerjee does disclose the code is composed of one of a two-dimensional code and a barcode **(Column 7, lines 3-18).**

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to dispense the secured and authentic item to be dispensed, and or printed that can also produce a searchable database of information relating to users and products associated with the service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R. Beckley whose telephone number is 571-270-3432. The examiner can normally be reached on Mon-Fri: 7:30-5:00 EST (Alternate Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. R. B. /
/Jonathan R Beckley/
Examiner, Art Unit 4178

11/20/07

/Hai Tran/

Supervisory Patent Examiner, Art Unit 4178